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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,638	04/21/2004	James D. Shaffer	TARINFO.015C1	5323
27189	7590	03/09/2006		
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101			EXAMINER AVELLINO, JOSEPH E	
			ART UNIT 2143	PAPER NUMBER

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,638

Applicant(s)

SHAFFER ET AL.

Examiner

Joseph E. Avellino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/30/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 are presented for examination; claim 1, 12, and 19 independent.
The Office acknowledges the addition of claims 12-20; claims 12 and 19 independent.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

3. Applicant's submission of an IDS dated November 30, 2005 has been considered. See enclosed PTO-1449.

Double Patenting

4. See previous Office Action for rationales for non-statutory double patenting rejections.

Claims 1-26 of Patent no. 6,748,426 contains every element of claims 1-11 of the instant application and as such anticipates claims 1-11 of the instant application.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5, 8-10, 12, 13, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman et al. (USPN 5,948,061) (cited by Applicant in IDS) (hereinafter Merriman).

6. Referring to claim 1, Merriman discloses a computerized information system for retrieving consumer data over a network, comprising:

a first information server (i.e. server housing advertising server process 19) for receiving a consumer identifier (i.e. IP address) from a consumer network interface device (i.e. client computer) (col. 5, lines 10-33);

a Linkage Key conversion module comprising instructions for converting the consumer Identifier into a Linkage Key (i.e. look up user IP address to retrieve identification number) (col. 5, lines 33-40);

a Linkage Key database comprising consumer data indexed by the Linkage Key (i.e. database containing all the information known about the user) (Figure 3A, col. 5, lines 33-62); and

instructions for comparing the Linkage Key to the linkage database in order to retrieve consumer data from the linkage database (col. 5, lines 50-63).

Merriman does not explicitly state using a second information server to convert the consumer identifier into a Linkage Key, however Merriman does disclose that the ad server can comprise one or more servers (col. 4, lines 20-25). This would give motivation for one of ordinary skill in the art to modify the system of Merriman to move

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the user identification subsystem to another server, thereby creating a second information server which receives the consumer identifier over the network from the first information server (i.e. it is well known that servers are connected via a network connection, and that in order for the second server to be able to convert the consumer identification, it must be received from the first server) and a linkage key conversion module for converting the consumer identifier into a linkage key. It would have been obvious to one of ordinary skill in the art to modify the teaching of Merriman to place the Linkage key conversion module on another server in order to reduce computer processing on the first server, thereby reducing the likelihood of overloading the first server. Furthermore it has been held obvious to make parts separable. See *Nerwin v. Erlichman* 168 USPQ 177 (1969) and MPEP 2144.04.

7. Referring to claim 2, Merriman discloses the consumer network interface device is a personal computer or PDA (col. 3, line 25).

8. Referring to claim 5, Merriman discloses the consumer identifier is an IP address (col. 5, lines 35-45).

9. Referring to claim 8, Merriman discloses the information server comprises an Internet server (Figure 1).

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10. Referring to claim 9, Merriman discloses the Internet server comprises instructions for writing the consumer identifier to a consumer's computer (i.e. the IP address is inherently transmitted to the destination in the return packet with the data) (col. 5, lines 10-60).

11. Referring to claim 10, Merriman discloses the Internet server writes a cookie data file to the consumer's computer (col. 5, lines 20-40).

12. Claims 12, 13, 19, and 20 are rejected for similar reasons as stated above.

Claims 3, 4, 6, 7, 11, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Shaffer et al. (USPN 5,901,214) (hereinafter Shaffer).

13. Referring to claims 3, 4, and 6, Merriman discloses the invention substantively as described in claim 1. Merriman does not specifically disclose the linkage key is a spatial key that defines a geographic location. In analogous art, Shaffer discloses another system for retrieving consumer data over a network which shows a linkage key as a spatial key which defines a geographic location (i.e. a zip code) (col. 11, lines 55-60). It would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Shaffer since Merriman remains silent as to how a user identification is assigned to a user (col. 5, lines 10-30). This would lead one of ordinary skill in the art to

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search for other methods as to how a user can be identified in a database system, eventually finding the system of Shaffer and its novel use of linkage keys as zip codes (col. 1, line 30 to col. 12, line 25).

14. Referring to claim 7, Merriman discloses the invention as described in claim 1. Merriman does not specifically disclose the linkage key conversion module converts a consumer address into a US delivery point code. In analogous art, Shaffer discloses converting a consumer address (i.e. a consumer's telephone number) into a USDPC (col. 12, lines 45-60). It would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Shaffer since Merriman remains silent as to how a user identification is assigned to a user (col. 5, lines 10-30). This would lead one of ordinary skill in the art to search for other methods as to how a user can be identified in a database system, eventually finding the system of Shaffer and its novel use of linkage keys as zip codes (col. 1, line 30 to col. 12, line 25).

15. Referring to claim 11, Merriman discloses the invention substantively as described in claim 1. Merriman does not disclose the consumer data is household data, individual data, census data, business location data, financial data, product consumption scores, maps, directions, address, property data, environmental data and geography related data. In analogous art, Shaffer discloses the consumer data is household data, individual data, census data, business location data, financial data, product consumption scores, maps, directions, address, property data, environmental

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data and geography related data (Figure 1). It would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Shaffer since Merriman remains silent as to how a user identification is assigned to a user (col. 5, lines 10-30). This would lead one of ordinary skill in the art to search for other methods as to how a user can be identified in a database system, eventually finding the system of Shaffer and its novel use of linkage keys as zip codes (col. 1, line 30 to col. 12, line 25).

16. Claims 14-18 are rejected for similar reasons as stated above.

Response to Amendment

17. The Office has considered the amendments to the independent claims. The double patenting rejection to Application nos. 10/732,147 10/454,396, and Patent nos. 6,661,884, 6,608,892, 6,570,975, 6,385,312, 6,381,324, 6,185,290, 6,091,810, 6,058,179, 5,982,868, 5,956,397, 5,910,982, 5,907,608, 5,848,131, 5,506,897, and 5,901,214 is withdrawn, however Applicant stated that a terminal disclaimer is filed for the double patenting rejection against patent 6,748,426. No Terminal Disclaimer has been received. It appears that this was a bona fide response to the Non-Final Action and that no deception was intended. Applicant is requested to submit the terminal disclaimer for patent 6,748,426.

Response to Arguments

18. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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21. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993). Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEA
February 22, 2006



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